

REMARKS

In the nonfinal Office Action mailed April 15, 2005, the Examiner withdrew from consideration claims 49-58 as being drawn to a nonelected species; objected to the title for not describing the claimed subject matter; rejected claims 32-35 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,602,661 to *Schadt et al.* ("*Schadt*"); rejected claims 36-41 and 47 under 35 U.S.C. § 103(a) as being unpatentable over *Schadt* in view of Japanese Patent No. JP409304770A to *Kameyama et al.* ("*Kameyama*"); and objected to claims 42-46 and 48 as being allowable, but depending from a rejected base claim.

By this Amendment, Applicants amend claims 32-46 and 48, and cancel claim 47 and add claim 59. Claims 32-46 and 48-59 remain pending in this application, with claims 49-58 being withdrawn from consideration. Applicants respectfully traverse the Examiner's rejections for the reasons provided below.¹

Objection to the Title

The Examiner objected to the application's title for not describing the claimed subject matter. Although Applicants do not acquiesce to the objection, Applicants have amended the title to read, "Element for Protection Against Forgery or Copying Containing a Structured Retarder and a Polarizer Layer." Applicants submit that the

¹ The Office Action contains statements characterizing the related art and the claims. Regardless of whether any such statements are specifically identified herein, Applicants decline to automatically subscribe to any statements in the Office Action.

title, as amended, sufficiently describes the claimed subject matter and respectfully request that the Examiner withdraw the objection to the title.

Rejection of Claims 32-35 Under 35 U.S.C. § 102(b)

In order to properly establish that *Schadt* anticipates Applicants' claims 32-35, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in the single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." (See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).) Even if the prior art device performs all the functions recited in the claim, the prior art cannot anticipate the claim if there is any structural difference. (See M.P.E.P. § 2114.)

Schadt pertains to optical components for use in display technology. (Col. 1:11.) In the Office Action, the Examiner alleges that the optical component shown in Fig. 3 anticipates the subject matter of claim 32. (Office Action, p. 3:14-22.) Fig. 3, in particular, shows the structure of a super-twisted nematic ("STN") cell. Further, the Examiner alleges that intermediate layer 9 and linear output polarizer 8 correspond to the recited "structured retarder" and "circular polarizer," respectively. (Office Action, p. 3:16-21.) In addition, in the rejection of claim 47, the Examiner asserts that linear input polarizer 4 corresponds to the claimed "external linear polarizer." (Office Action, p. 5:14-17.) Applicants respectfully disagree.

Schadt cannot anticipate the claimed subject matter because it fails to disclose all of the features recited in claim 32. As amended, independent claim 32 incorporates the subject matter previously recited in claim 47 and defines: "An element for protection against forgery or copying, including: an optical component comprising at least two layers, one layer being a structured retarder and the other layer being a polarizer, wherein the polarizer is a circular polarizer; and an external linear or circular polarizer for analyzing encoded information." Among other things, *Schadt* fails to disclose, "an external linear or circular polarizer for analyzing encoded information," defined in the claim.

In particular, the STN cell disclosed by *Schadt* has a layered structure. (See, e.g., Fig. 3, Col. 1:55-65.) Input polarizer 4 and output polarizer 8 appear to be layers of the STN cell. Nowhere does *Schadt* disclose input polarizer 4 and output polarizer 8 as being external to the STN cell. Accordingly, *Schadt* fails to teach or suggest "an external linear or circular polarizer," as required by claim 32.

The Examiner appears to interpret input polarizer 4 as being external to the STN cell and output polarizer 8 as being internal to the STN cell. To the contrary, Fig. 3 illustrates input polarizer 4 and output polarizer 8 as having a similar relationship to the STN cell. As shown, input polarizer 4 is adjacent to glass plate 1 and output polarizer 8 is adjacent to glass plate 5. Therefore, if input polarizer 4 is regarded as being external to the STN cell, then output polarizer 8 is also external. In that case, claim 32 (even in its original form) is not anticipated by *Schadt* since both input polarizer 4 and output polarizer 8 are external polarizers and, thus, *Schadt* does not disclose "an optical

component comprising at least two layers, one layer being a structured retarder and the other layer being a polarizer,” as recited in claim 32.

On the other hand, if the Examiner interprets output polarizer 8 as a “layer” of the STN cell, then input polarizer 4 must also be interpreted as a layer. In such a case, *Schadt* also fails to anticipate claim 32 because it does not disclose “an external linear or circular polarizer,” as recited in claim 32.

Accordingly, *Schadt* does not teach an element for protection against forgery or copying, including, at least, “two layers, one layer being a structured retarder and the other layer being a polarizer, wherein the polarizer is a circular polarizer; and an external linear or circular polarizer for analyzing encoded information,” as required by claim 32. For at least this reason, the rejection based on *Schadt* is improper.

Schadt also does not teach or suggest “an external linear or circular polarizer for analyzing encoded information,” as recited in claim 32. The STN cell disclosed by *Schadt* pertains to a STN cell for display purposes. Indeed, nowhere does *Schadt* describe information being encoded. Accordingly, *Schadt* fails to anticipate claim 32 for this reason as well.

Moreover, *Schadt* fails to disclose “An element for protection against forgery or copying,” as recited in the preamble of claim 32. Statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the recited purpose or intended use results in a structural difference between the claimed invention and the prior art; if so, the recitation serves to limit the claim.

(See, e.g., *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963).) If a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. (See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).)

Here, Fig. 3 of *Schadt* discloses an optical element for a video display. (Col. 7:3-6.) However, this optical element is not usable as “[a]n element for protection against forgery or copying.” Therefore, because the optical element disclosed by *Schadt* is not capable of “protect[ing] against forgery or copying” as recited in the preamble of claim 32, it does not anticipate the claimed subject matter.

For at least the reasons discussed above, *Schadt* fails to teach or suggest each and every element recited in claim 32. Accordingly, *Schadt* cannot support a rejection of claim 32 under 35 U.S.C. § 102(b). Applicants, therefore, respectfully request the Examiner reconsider and withdraw the of claim 32, and allow the claim.

Claims 33-48 depend from independent claim 32. Since *Schadt* does not support the rejection of claim 32 under 35 U.S.C. § 102(b), *Schadt* also does not support the rejection of dependent claims 33-48 for at least the reasons set forth above in connection with claim 32. Therefore, Applicants also request that the rejection of claims 33-48 under 35 U.S.C. § 102(b) be withdrawn and the claims allowed.

Rejection of claims 36-41 Under 35 U.S.C. § 103(a)

The Examiner rejected claims 36-41 under 35 U.S.C. § 103(a) as being unpatentable over *Schadt* in view of *Kameyama*. To establish a *prima facie* case of

obviousness, three basic criteria must be met. First, the prior art reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. (See M.P.E.P. § 2143 (8th ed. 2001, revised May 2003).) Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. (*Id.*) Third, a reasonable expectation of success must exist. (*Id.*) Moreover, each of these requirements must “be found in the prior art, and not based on applicant’s disclosure.” (*Id.*)

As discussed above, *Schadt* fails to anticipate the subject matter recited in claim 32. The Examiner purportedly cites *Kameyama* for its disclosure of a separation layer for circular polarized light and laminating plural cholesteric layers. (Office Action, p. 4:21-25.) However, *Kameyama* fails to cure the above-identified deficiencies of *Schadt*. Accordingly, *Schadt* and *Kameyama*, taken individually or in any proper combination, do not to teach or suggest each and every feature recited in claims 36-41. Therefore, in view of the dependency of claims 36-41 from claim 32, *Schadt* and *Kameyama*, cannot support a rejection of claims 36-41 under 35 U.S.C. § 103(a). Accordingly, Applicants respectfully request the rejection of claims 36-41 under 35 U.S.C. § 103(a) be withdrawn and the claims allowed.

New Claim 59

Applicants have added new dependent claim 59 to further clarify features of the invention. Support for the subject matter of claim 59 can be found in the specification at, for example, pages 3, lines 19-21 and 6, lines 5-7.

Claim 59 depends from independent claim 32. Since, as discussed above, *Schadt* and *Kameyama*, taken individually or in combination, fail to support the rejection of claim 32. Claim 59 should also be deemed allowable over the prior art. In addition, Applicants submit that *Schadt* and *Kameyama* fail to teach or suggest an element having at least two layers wherein "information is encoded in at least one of said layers," as recited in claim 59. Accordingly, claim 59 is allowable for this reason as well.

Conclusion

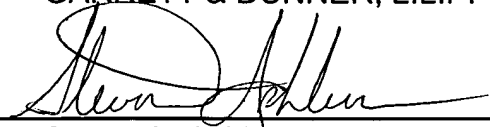
In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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